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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/498,801 01/31/00 BOYD

G 55241USA9A

EXAMINER

MM21/0827

Attention William D Miller
Office Of Intellectual Property Counsel
3M Innovative Properties Company
PO BOX 33427
St.Paul MN 55133-3427

SHAFFER, R

ART UNIT

PAPER NUMBER

2872

DATE MAILED:

08/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/498,801

Applicant(s)

BYD ET AL

Examiner

R.D. SHAFFER

Group Art Unit

2872

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 month MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 6/11/01

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-35 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claim(s) 1-35 are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

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1. The restriction requirement set forth in Paper No. 6 is withdrawn. A corrected restriction requirement follows.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 2-9, drawn to an illuminated display device comprising a first light source, a reflective image display and a reflective polarizing film with particular polarizing film details, classified in class 362, subclass 19. Bsp

II. Claim 10, drawn to an illuminated display device comprising a first light source, a reflective image display, a reflective polarizing film and a viewing port with particular placement of the polarizing film, classified in class 362, subclass 19. AB

III. Claim 11, drawn to an illuminated display device comprising a first light source, a reflective image display, a reflective polarizing film and a clean-up polarizer, CB classified in class 362, subclass 19.

IV. Claims 12-16, drawn to an illuminated display device comprising a first light source, a reflective image display, a reflective polarizing film and a reflector with or without particular polarizing film details, classified in class 362, subclass 19. O.B. Bsp

V. Claims 17-26, drawn to an illuminated display device comprising a first light source, a reflective image display, a reflective polarizing film and a diffuser, LB classified in class 362, subclass 19.

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VI. Claim 27, drawn to an illuminated display device comprising a first light source, a reflective image display, a reflective polarizing film and a second light source, classified in class 362, subclass 19.

FB

VII. Claim 28, drawn to an illuminated display device comprising light generating means for emitting diffuse, polarized light; reflective display means for modulating reflected light with an image and reflective polarizing means, classified in class 359, subclass 247.

GB

VIII. Claims 29-35, drawn to an illuminated display device comprising a first light source, a reflective image display, a reflective polarizing film and a controller, classified in class 396, subclass 281.

HB

3. Claim 1 link(s) inventions I-VI and VIII. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is

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withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

4. The inventions are distinct, each from the other because of the following reasons:

Inventions [II-VI, VIII] and [I, VII] are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of the omission of the particular polarizing film details or the details of the reflective display means modulates reflected light with an image. The subcombination has separate utility such as an illuminated display device without a viewing port, a clean-up polarizer, a reflector, a second light source or a controller.

Inventions IV and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of omission of the particular polarizing film details. The subcombination has separate utility such as an illuminated display without a reflector.

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Inventions II-VI and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each of the inventions II-VI and VIII has separate utility such as an illuminated display with the separate details of the other invention(s). For example, the illuminated display of invention II has separate utility as an illuminated display without the clean-up polarizer of invention III, the reflector of invention IV, the diffuser of invention V, the second light source of invention VI or the controller of invention VIII, the illuminated display of invention III has separate utility as an illuminated display without the viewing port of invention II, the reflector of invention IV, the diffuser of invention V, the second light source of invention VI or the controller of invention VIII, ...etc. See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification or recognized divergent subject matter or the search required for one the inventions is not required for any of the remaining inventions as indicated below. Therefore, restriction for examination purposes as indicated as proper.

The search required for invention I would further require a search in class 359, subclass 490 which would not be required for inventions II-VI.

The search required for invention III would further require a search in class 359, subclass 501 which would not be required for inventions I, II, IV, V and VI.

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The search required for invention IV would further require a search in class 362, subclass 560 which would not be required for inventions I-III, V and VI.

The search required for invention V would further require a search in class 362, subclass 558 which would not be required for inventions I-IV and VI.

The search required for invention VI would further require a search in class 362, subclass 227 which would not be required for inventions I-V.

6. This application contains claims directed to the following patentably distinct species of the claimed invention:

- A). The species depicted by Fig. 4;
- B). The species depicted by Fig. 5;
- C). The species depicted by Fig. 9A;
- D). The species depicted by Fig. 9B;
- E). The species depicted by Fig. 9D;
- F). The species depicted by Fig. 9E;
- G). The species depicted by Fig. 9F;
- H). The species depicted by Fig. 9G;
- I). The species depicted by Fig. 11B;
- J). The species depicted by Fig. 12;
- K). The species depicted by Fig. 13; and
- L). The species depicted by Fig. 14B.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species consistent with the elected invention for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, several claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

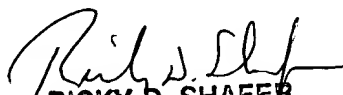
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8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R.D. Shafer whose telephone number is (703) 308-4813.

Shafer/RDS

08/22/2001


RICKY D. SHAFER
PATENT EXAMINER
ART UNIT 2872